IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

POLAROID CORPORATION, Plaintiff and Counterclaim Defendant, v. HEWLETT-PACKARD COMPANY, Defendant and Counterclaim Plaintiff.	C.A. No. 06-738-SLR

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DEFENDANT HEWLETT-PACKARD COMPANY'S MEMORANDUM IN SUPPORT OF ITS MOTION TO PRECLUDE CERTAIN TESTIMONY OF POLAROID'S EXPERT DR. PEGGY AGOURIS

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Dated: May 23, 2008

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Defendant Hewlett-Packard Company ("HP") hereby moves for an order excluding opinions of Polaroid Corporation's expert, Dr. Peggy Agouris, relating to, or based upon, an interpretation of source code, or the equivalents of hardware and software as means to perform the function stated in claims 1-3 of U.S. Patent No. 4,829,381 (the "'381 patent").

I. NATURE AND STAGE OF THE PROCEEDINGS

This is a patent infringement case. Polaroid alleges that certain image enhancement software, called "LACE," infringes the '381 patent. Fact and expert discovery have been completed. Summary judgment motions and supporting memoranda have been filed. This is one of two *Daubert* motions being filed by HP.

II. SUMMARY OF ARGUMENT

An expert may not properly state opinions that depend for their reliability on the conclusions of another expert, who has not testified, whose qualifications are undisclosed, and whose work has not been (and could not be) supervised by the testifying expert. Dr. Peggy Agouris is Polaroid's expert with respect to issues of infringement, validity, marking and non-infringing alternatives. Her testimony is based upon

This other expert did not provide an expert report. Dr. Agouris's opinions should be precluded insofar as they are based upon the opinions of another expert outside her field of expertise.

In addition, Dr. Agouris opines

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Dr. Agouris is, not competent to render that opinion. All such testimony should be precluded.

III. STATEMENT OF FACTS

Dr. Peggy Agouris states *See* Expert Report of Dr. Peggy Agouris Regarding U.S. Patent No. 4,829,381 ("Agouris Expert Report I"), filed herewith as Exhibit A to the Declaration of William J. Marsden, Jr. ("Marsden Decl."), at 4. In her expert report, Dr. Agouris

Id. at 12-13. In addition, Dr. Agouris opined

Id. at 80-84. Dr. Agouris further opined

Id. at 90-98.

At her deposition, Dr. Agouris of

Deposition of Dr. Peggy Agouris ("Agouris Dep.") (Marsden Decl. Ex. B.) at 51:11-12

id. at 53:2-4

id. at 58:3-5

the

Agouris Dep., 51:20-52:2.

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Id. at 50:2-51:1.[1]

Id. at 52:6-7.

Dr. Agouris has Agouris Dep. at pp. 50:24-25; 51:23-24; 53:4; 57:4-5; 58:25-59:4; 198:2; 221:10. During her deposition, she Agouris Dep. at pp. 51:24-25; 55:11-12; 56:17-20. Dr. Agouris testified *Id.* at pp. 57:25-58:3.

Rather, for all of her source code-related opinions, Dr. Agouris Agouris Expert Report I at 28, n.4. Mr. Wroblewski did not provide an expert report of any type. His qualifications as an expert, his potential bias, his methodology, his actual opinions and the reasons for his opinions are entirely unknown. In fact, the only specifics that either Polaroid or Dr. Agouris has provided to HP are as follows:

- (*id.* at 53:9-13);
- (*id.* at 54:10-14);

[1] It is noteworthy that Polaroid's witnesses have (*see, e.g.*, Deposition of Jay Thornton ("Thornton Dep.") at 37:21-22; 43:18-23) (Marsden Decl. Ex. C); and that Polaroid's counsel have repeatedly suggested the same through their questioning of HP's experts (*see, e.g.*, Deposition of Dr. Dan Schonfeld ("Schonfeld Dep.") (Marsden Decl. Ex. D) at pp. 45:14-46:3, 172:11-173:19, 353:14-354:3).

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- (*id.* at 55:1-56:16);
- (*id.* at 197:24-198:7);
- (*id.* at 206:23-210:4);
- (*id.* at 217:6-221:22; 227:13-228:5);
-

In addition, claims 1-3 of the '381 patent are written in means plus function form. *See* 35 U.S.C. § 112, ¶ 6. The '381 patent includes an extended discussion of a computer device and circuitry that would perform the functions recited in these claims -- *i.e.*, that are the claimed means. It is undisputed that HP does Dr. Agouris has opined that "

Agouris Expert Report I at 45.

Agouris Dep. at 172:12-24; 205:12-24.

Id. at 205:20-25.

The last deadline for expert reports was April 18, 2008. The deadline for the completion of expert discovery was May 9, 2008. Mr. Wroblewski provided no expert report.

IV. ARGUMENT

A. Legal Standard

Under Federal Rule of Evidence 702, an expert must base his or her opinions "upon sufficient facts or data," so that the expert's work is "the product of reliable principles and methods." Federal Rule of Evidence 702. The expert must then apply those methods and principles "reliably to the facts of the case." *Id.* As the Supreme Court has emphasized, the trial court has an essential "gatekeeping" function to "ensur[e] that an expert's testimony both rests on a reliable foundation and is relevant to the task at hand." *Daubert v. Merrell Dow Pharmaceuticals*, 509 U.S. 579, 597 (1993); *see also Kumho Tire Co. v. Carmichael*, 526 U.S. 137, 141 (1999) (trial court's gatekeeping function "applies . . . to testimony based on 'technical' and 'other specialized' knowledge").

"The *Daubert* test must be applied with due regard for the specialization of modern science. A scientist, however well credentialed he may be, is not permitted to be the mouthpiece of a scientist in a different specialty." *Dura Automotive Systems of Indiana, Inc. v. CTS Corporation,* 285 F.3d 609, 614 (7th Cir. 2002). Where, as here, a testifying expert relies on "assistants" that are more than mere data-collectors, and where the testifying expert "lacks the necessary expertise to determine whether the techniques [employed by those "assistants"] were appropriately chosen and applied," the testifying expert is not competent to testify to, and may not base her conclusions on, the opinions of an expert in another area of specialty. *Id.* at 615; *see also Malletier v. Dooney & Bourke, Inc.*, 525 F. Supp. 2d 558, 664 (S.D.N.Y. 2007) (finding the testifying expert's reliance on another expert improper); *Telecom, S.A. v. Tekelec*, 472 F. Supp. 2d 722, 729-730 (E.D.N.C. 2007).

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B. Any Testimony By Dr. Agouris Based Significantly On The Analysis Of An Unproduced Expert Should Be Precluded

1. Dr. Agouris's source code-related and hardware/software equivalency opinions are inherently unreliable.

Dr. Agouris should be precluded from offering any opinion that is based in significant part on the analysis of another expert who has not submitted an expert report and whose work she was not competent to supervise or evaluate.

In *Malletier, supra*, for example, a "regression analysis" at issue had been conducted by another expert. The testifying expert's knowledge of the conduct of such studies was based only on studying statistics 30 years earlier. 525 F. Supp. 2d at 664. The court stated that, while "[i]t is true that experts are permitted to rely on opinions of other experts to the extent that they are of the type that would be reasonably relied upon by other experts in the field . . . in doing so, the expert witness must in the end be giving his *own* opinion." *Id.* (emphasis in original). The testifying expert "cannot simply be a conduit for the opinion of an unproduced expert." *Id.*

In the case at bar, Dr. Agouris

These opinions should be precluded. In addition, Dr. Agouris has opined

Compare McReynolds v. Sodexho Marriott Services, Inc., 349 F. Supp. 2d 30, 37 (D.D.C. 2004) (allowing testifying expert to rely on assistants where the testifying expert was able to independently verify the underlying work and determine if it was performed as he requested or whether any significant mistakes were made).

Examples of testimony that should be precluded are:

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a. HP's marking defense. Polaroid has the burden of demonstrating compliance with the marking statute. *Dunlap v. Schofield*, 152 U.S. 244, 248 (1894) ("the duty of alleging and the burden of proving [notice] is upon the plaintiff"); *Soverain Software LLC v. Amazon.com, Inc.*, 383 F. Supp. 2d 904, 908 (E.D. Tex. 2005) ("The patentee bears the burden of proving compliance with the marking statute by a preponderance of the evidence.") (citing *Nike, Inc. v. WalMart Stores, Inc.*, 138 F.3d 1437, 1446 (Fed. Cir. 1998)). Polaroid concedes that it has not marked any product to indicate that it embodies a claim of the '381 patent. Polaroid asserts that the subject matter claimed in its '381 patent was never included in a Polaroid commercial product, and that, as a result, it had no obligation to mark. Dr. Agouris opines

She is not competent to render these opinions because

b. Non-infringing alternatives. Retinex is image enhancement software developed by HP that performs HP asserts that Retinex source code was a non-infringing alternative to LACE source code. Dr. Agouris has opined

Her opinion is necessarily a derivative of Mr. Wroblewski's undisclosed analysis.

c. Infringement of claims 1-3 of the '381 patent. Claims 1-3 are stated means plus function form. The '381 patent discloses a particular algorithm used in combination with computer hardware that is described in detail in the patent. This combination is the means that is disclosed in the '381 patent as performing the function stated in claims 1-3. Although

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Dr. Agouris

She is not qualified to render this opinion.

d. Doctrine of Equivalents/Structural Equivalents. Throughout the expert report, Dr. Agouris opines[2]

Any analysis of the doctrine of equivalents requires consideration of the function, way, result test.

[2] *E.g.*, Agouris Expert Report I states at p. 41:

Agouris Report I states at p. 45:

Agouris Dep. at 205:20-25.

2. Dr. Agouris's source code-related testimony is also inadmissible hearsay.

Any testimony by Dr. Agouris will also constitute hearsay evidence. *See Malletier,* 525 F. Supp. 2d at 666. For example, in *Malletier*, the court found that an expert's testimony regarding the findings of the underlying expert would violate the hearsay rule. Any such testimony would constitute the statement of an out-of-court declarant which was not admissible under any hearsay exception. *Id.* The court stated that while "[i]t is true that under Rule 703, experts can rely on hearsay in reaching their own opinions . . . a party cannot call an expert simply as a conduit for introducing hearsay under the guise that the testifying expert used the hearsay as the basis of his testimony." *Id.* Here, as in *Malletier*, the testifying expert's testimony has "no probative value independent of [the underlying expert's] report." *Id.*

C. Any Testimony By Mr. Wroblewski Should Be Precluded Under Rule 37(c)

Mr. Wroblewski was not disclosed by Polaroid as an expert. He has not provided an expert report. The deadline for expert disclosures and expert discovery has passed. Fed. R. Civ. P. 37(c)(1) provides that, in these circumstances, testimony by Mr. Wroblewski is precluded. *See, e.g., Dura,* 285 F.3d at 615-616; *In re Sulfuric Acid Antitrust Litigation*, 235 F.R.D. 646, 653 (N.D. Ill. 2006) (noting that *Dura* "made clear that Rule 703 was not an exception to the hearsay rule, and that one expert could not be the mouthpiece for another. If the latter had not been properly disclosed, he could not testify, and in that event the former's testimony would rest on air").

V. CONCLUSION

For the reasons set forth above, HP respectfully requests that the Court preclude any testimony of Dr. Peggy Agouris which (1) relies on, or relates to, an interpretation of source code, or (2) constitutes an opinion that hardware and software are equivalent as means to perform the function stated in claims 1-3 of the '381 patent.

Dated: May 23, 2008

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RULE 7.1.1 CERTIFICATE

The undersigned certifies that counsel for movants have made reasonable effort to reach agreement with the opposing attorneys on the matters set forth in the motion.

s/ *William J. Marsden, Jr.*
William J. Marsden, Jr.

CERTIFICATE OF SERVICE

I hereby certify that on May 23, 2008, I electronically filed with the Clerk of Court the foregoing document using CM/ECF which will send electronic notification of such filing(s) to the following counsel:

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